

IN THE MATTER OF AN OPPOSITION by The Molson Companies Limited, now Molson Companies, A Partnership, to application No. 537,657 for the trade-mark PERONI NASTRO AZZURRO & Design filed by S.P.A. Birra Peroni Industriale

On March 1, 1985, the applicant, S.P.A. Birra Peroni Industriale, filed an application to register the trade-mark PERONI NASTRO AZZURRO & Design, a representation of which appears below, based upon use and registration of the trade-mark in Italy in association with "brewed alcoholic beverages". The applicant disclaimed the right to the exclusive use of all the reading matter except the words NASTRO AZZURRO apart from its trade-mark. Additionally, the applicant claimed colour as a feature of its trade-mark, the application including the following claim:

"The mark is in two parts. The upper part comprises a gold border within which are spaced, parallel, arcuate silver lines. the (sic.) printing parallel to these lines and transverse to these lines at one end is in red, the central seal has a gold background with blue printing. The vertical ribbon-like (sic.) element is blue. The lower portion of the mark has a white background upon which are superimposed spaced, parallel, horizontal silver (sic.) lines. The central hexagonal border is gold, the words BIRRA, PERONI and SPECIALE are in white on a blue background, the words NASTRO AZZURRO are in red and the seal has a central white portion upon which the printing is blue; an annular gold portion upon which the printing is blue, the annular gold portion having blue inner and outer borders."

The applicant claimed and was accorded a priority filing date of February 7, 1985 based on its application for registration of the trade-mark filed in Italy.

The opponent, The Molson Companies Limited, filed a statement of opposition on October 21, 1986 in which it alleged that the applicant's trade-mark is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in view of the registration and prior user by the opponent of its following registered trade-marks:

<u>Trade-mark</u>	<u>Regn. No.</u>	<u>Wares/Services</u>
MOLSON'S EXPORT & Design	102,008	alcoholic brewery beverages
MOLSON'S EXPORT & Design	114,010	alcoholic brewery

		beverages
MOLSON EXPORT & Design	160,585	brewed alcoholic beverages
MOLSON EXPORT & Design	306,498	brewed alcoholic beverages
MOLSON EXPORT LIGHT & Design	305,861	brewed alcoholic beverages

as well as the following family of trade-marks comprising labels

"being hexagonal in shape":

<u>Trade-mark</u>	<u>Regn. No.</u>
MOLSON GOLDEN & Design	309,841
MOLSON EXPORT & Design	306,498
MOLSON EXPORT LIGHT & Design	305,861
MOLSON STOCK ALE & Design	300,903
M & Design	296,917
MOLSON GOLDEN & Design	293,246
MOLSON GOLDEN & Design	290,098
MOLSON LEGERE LIGHT & Design	281,288
MOLSON LIGHT & Design	268,661
OKTOBERFEST BEER & Design	261,790
FRONTIER STOUT & Design	240,196
LAURENTIDE BIÈRE & Design	235,134
BRADOR & Design	234,828
MOLSON DIAMOND LAGER & Design	232,024
BRADOR & Design	191,155
MOLSON REVEILLON & Design	184,554
MOLSON EDMONTON EXPORT & Design	175,422
MOLSON PORTER VELOUTE & Design	163,256
MOLSON CREAM PORTER & Design	161,607
MOLSON STOCK ALE & Design	161,355
MOLSON GOLDEN ALE & Design	161,252
MOLSON EXPORT ALE & Design	160,585
EXPORT BEER & Design	159,081
LAURENTIDE BIÈRE & Design	151,179
M & Design	141,936
MOLSON CANADIAN & Design	139,874
MOLSON'S CANADIAN & Design	122,424

The opponent also relied upon prior use of the trade-mark EXPORT in association with brewed alcoholic beverages in challenging the applicant's entitlement to registration and the distinctiveness of its trade-mark. In respect of its non-distinctiveness ground of opposition, the opponent alleged that it owns and has used extensively in Canada a family of trade-marks consisting of hexagonal shaped designs which have become recognized as trade-marks of the opponent, including the trade-mark EXPORT.

The applicant served and filed a counter statement in which it denied the allegations of confusion set forth in the statement of opposition.

The opponent filed as its evidence the affidavits of J David Lee, David J. Pye and Harold J. Moran. The applicant requested and was granted an order to cross-examine Mr. Moran on his affidavit and the opponent subsequently requested and was granted leave to replace the Moran affidavit with an affidavit of David Perkins. Mr. Perkins was cross-examined on his affidavit and the transcript of the cross-examination, as well as the undertakings furnished by the opponent, form part of the record in this opposition.

The applicant filed as its evidence the affidavits of Lynda Doxsee, John Opolko and Eric Burn. The applicant was subsequently granted leave to substitute the affidavit of Diane L. Way for that of Eric Burn. The applicant's affiants were cross-examined on their affidavits and the transcripts of the cross-examinations and the undertaking given during the cross-examination of Ms. Doxsee also form part of the opposition record.

Both the applicant and the opponent filed written arguments and both were represented at an oral hearing.

During the opposition, the opponent assigned its rights in its trade-marks to Molson Breweries, A Partnership, the present opponent of record.

The applicant has pointed out that paragraph 9 of the Perkins affidavit differs from paragraph 9 appearing in the draft copy of the affidavit which was filed with the Opposition Board in support of the opponent's request that it be permitted to submit it in place of the Moran affidavit. As leave was granted to the opponent on the basis of the draft of the Perkins affidavit which accompanied the opponent's correspondence of February 14, 1990, I have disregarded that portion of paragraph 9 of

the Perkins affidavit which did not appear in the draft of the affidavit. However, I do not accept the applicant's submission that the Perkins affidavit should be ruled as inadmissible in that the addition to paragraph 9 appears to serve no other purpose than to expand upon paragraph 15 of the Moran affidavit, a photocopy of which is annexed as Exhibit X to the Perkins affidavit.

The applicant in its written argument also submitted that a review of the transcript of Mr. Perkins cross-examination reveals that counsel for the opponent prevented Mr. Perkins from answering many of the questions posed. Several of the questions which were objected to by counsel for the opponent related to the Mr. Perkins ability to identify certain trade-marks associated with brewed alcoholic beverages based on photocopies of representations shown to the deponent during the cross-examination. As Mr. Perkins stated in his affidavit that he is aware of all brewed alcoholic beverage products "brewed and sold in Canada", the applicant arguably ought to have presented for identification during the cross-examination the actual labels from containers of brewed alcoholic beverages rather than photocopies of representations of trade-marks. In any event, the applicant was certainly free to submit as part of its evidence labels used in association with brewed alcoholic beverages in the marketplace. Further, it does not appear from the transcript of the Opolko cross-examination that counsel for the applicant was any less unreasonable in objecting to questions asked of Mr. Opolko than was counsel for the opponent during the Perkins cross-examination.

The Pye affidavit seeks to introduce into evidence the results of a study which Mr. Pye's company, Westmount Research Consultants Inc., designed and implemented for the opponent relating to consumer perception of the word "EXPORT". According to Mr. Pye, he personally designed the study, oversaw its implementation, and analyzed the results of the study although he selected Consumer Contact Limited to conduct the interviews and to do the interview answer data entry. Annexed to Mr. Pye's affidavit is a copy of the report containing statistical data, the affiant's findings, and the methodology used in the "EXPORT" study. The interviews were conducted by telephone in May 1985 in the province of Ontario from four central calling stations in Toronto, Sudbury, London and Ottawa and over 1,000 usable interviews were obtained from the parties who were contacted. The results of the survey indicated that 22.5% of the interviewees gave the answer "MOLSONS" on a first mention basis when asked question 6a.

Question 6a of the questionnaire, the key question asked during the interviews, together with the accompanying instruction, is as follows:

Thinking now of beer and ale, what is the first thing that comes into your mind when you hear the word "EXPORT"? (WRITE IN FIRST MENTION IN FULL).

The applicant submitted that the wares covered in the applicant's application and the opponent's

registrations are identified as "brewed alcoholic beverages" (or "alcoholic brewery beverages"), such that the reference to "beer and ale", the word ALE also appearing prominently on the opponent's labels, constituted a prompt. However, as brewed alcoholic beverages are normally identified as beer, ale, lager or the like, I would have had no concern with question 6a had it simply referred to "beer". However, the reference to "ale" arguably constitutes a prompt in that four of the opponent's trade-mark registrations prominently include the word "ALE". While it is difficult to assess the possible impact of such a prompt on an interviewee, I doubt that it would have had a significant impact on the results obtained in the study.

With respect to the admissibility and reliability of survey evidence in a trade-mark case, Mr. Justice MacKay in his reasons for judgment [Joseph E. Seagram & Sons Ltd. et al. v. Registrar of Trade Marks et al., 33 C.P.R. (3d) 454] dismissing an appeal from the decision of the Registrar of Trade-marks [3 C.P.R. (3d) 325] in respect of the registrability of the trade-mark SEAGRAM REAL ESTATE LTD. & Design, commented as follows [pp. 471-473]:

The opponent's survey evidence in this opposition appears to be subject to certain of the criticisms noted by Mr. Justice MacKay in the SEAGRAM REAL ESTATE LTD. & Design case. Affidavits of the persons who actually conducted the telephone interviews were not submitted as evidence even though the telephone interviewers and supervisors were allegedly told before completing any interviews that they would be required to swear an affidavit that they conducted the interview in an unbiased manner (see paragraph 11(e) of the Pye affidavit). Indeed, the opponent failed to file an affidavit from a representative of Consumer Contact Limited that the interviews were conducted and the questionnaires were completed in accordance with the instructions received from Mr. Pye. As a result, there is no direct evidence as to the manner in which the questionnaires were completed or the accuracy of the completed questionnaires. Further, the completed questionnaires were not even filed as evidence in the opposition.

In view of the absence of affidavit evidence from the interviewers and their supervisors, and considering the above comments with respect to questions 6a of the study, I have accorded less weight to the results of the study than I otherwise would have given them.

The Opolko affidavit introduces into evidence an Ontario Brewers Retail "Product List" (Exhibit "C") and a September 8, 1986 Product List of the Liquor Control Board of Ontario (Exhibit "I"). In so far as the applicant is relying on these exhibits as evidence that the products listed therein have been sold in Ontario, they are inadmissible as hearsay evidence. Furthermore, in the absence of evidence from officials of the boards, I am not prepared to infer anything from the mere existence of the product lists. As well, Mr. Opolko has annexed to his affidavit photocopies of pages from two publications published outside of Canada which were located by the affiant at the Toronto Public Library. However, the excerpts from these publications cannot be given much weight in that the applicant seeks to rely upon them as evidence of the truth of their contents. In any event, both publications appear to have been published subsequent to both the applicant's priority filing date and the date of opposition and would therefore only have been of relevance to the Section 12(1)(d) grounds of opposition.

The opponent's first ground is based on Section 12(1)(d) of the Trade-marks Act, the opponent asserting that the applicant's trade-mark is not registrable, the opponent being the owner of the following trade-mark registrations: registration No. 102,008, for use in association with "alcoholic brewery beverages; registration No. 114,010, covering "alcoholic brewery beverages; registration No. 160,585, for use in association with "brewed alcoholic beverages; registration No. 306,498, for use in association with "brewed alcoholic beverages; registration No. 305,861, covering "alcoholic brewery beverages; and a family of trade-marks comprising labels which are hexagonal in shape.

Registration No. 102,008

Registration No. 114,010

Registration No. 160,585

Registration No. 306,498

Registration No. 305,861

With respect to the grounds of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision in view of the recent decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, (1991), 37 C.P.R. (3d) 413 and the recent decision of the Opposition Board in Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, (1991), 37 C.P.R. (3d) 538. The material date with respect to the non-distinctiveness grounds is the date of opposition (October 21, 1986) while the material date in relation to the non-entitlement grounds of opposition is the priority filing date of the applicant's application (February 7, 1985).

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the material dates in this opposition.

Considering the inherent distinctiveness of the trade-marks at issue, the applicant's trade-mark PERONI NASTRO AZZURRO & Design is inherently distinctive when considered in its totality even though the reading matter, but for the words NASTRO AZZURRO, has been disclaimed by the applicant apart from its trade-mark. Likewise, when considered in their entirety, the opponent's MOLSON EXPORT & Design and MOLSON'S EXPORT & Design trade-marks are inherently distinctive despite the surname significance of MOLSON or MOLSON'S and the inclusion of the word EXPORT which, as an element of a trade-mark applied to brewed alcoholic beverages, designates the kind or possibly the destination of the wares in terms of the product being intended for a market outside of Canada. In this regard, I would note the following comments from the decision of the Trade Marks Opposition Board in Molson Companies Ltd. v. Scottish & Newcastle Breweries Ltd., 4 C.P.R. (3d) 124, at page 131:

"Indeed, I would note that s-s. 4(3) of the Trade Marks Act clearly contemplates use of a trade mark when the mark is applied to wares or packages in which the wares are contained in Canada when the wares are exported from Canada. As such, the term "export" would apply to any wares and is common to trade in general. Further, the term "export mark" has been accepted as having a known meaning in association with a trade mark which identifies goods destined for export as noted by Fox in *The Canadian Law of Trade Marks and Unfair Competition*, 3rd. ed. (1972), at p. 46. Also, in Webster's Third New International Dictionary, the word "export" includes as one of its definitions "suitable or designed for exportation" and, as such, the word "export" as a trade mark or as a component of a trade mark would designate the kind and possibly the destination of the wares in terms of the product being intended for a market outside of Canada. Further, the Oxford English Dictionary includes the following definition for the word "export": "b. attrib. or quasi-adj. Designating an article of a quality suitable for exporting, usually of a better quality than that made for home consumption. Also ellipt., beer of export quality; a glass of this beer."

The applicant's trade-mark application is based upon use and registration of the trade-mark PERONI NASTRO AZZURRO & Design in Italy and no evidence has been adduced by the applicant that it has commenced use of its trade-mark in Canada. As a result, the applicant's trade-mark must be considered as not having become known to any extent in Canada. On the other hand, the Perkins affidavit establishes that the opponent's trade-mark MOLSON EXPORT & Design has become well known in Canada in association with ale. Likewise, the length of time that the trade-marks have been in use clearly weighs in the opponent's favour.

The wares associated with the trade-marks at issue are identical as would be the channels of trade associated with the "brewed alcoholic beverages" of the parties.

With respect to the degree of resemblance between the trade-marks at issue, the opponent submitted that the words EXPORT LAGER are the only reading matter in the English language in the applicant's trade-mark and would therefore constitute a dominant element of the applicant's design mark. However, as noted above, the word EXPORT is not distinctive as applied to brewed

alcoholic beverages and the word LAGER is the name of the wares, thus minimizing the impact that these words would have on the average consumer. On the other hand, the word EXPORT appears in relatively large size block lettering in the opponent's trade-marks and would be perceived as a dominant element of the opponent's marks in so far as distinguishing the opponent's brewed alcoholic beverages from those of others. In this regard, and as noted at page 133 of the Molson Companies v. Scottish & Newcastle decision, referred to previously, the surname MOLSON or MOLSON'S would be recognized by the average consumer as "a house mark of the opponent while the word EXPORT would be perceived as being used to designate a particular brand of beer originating from Molson or Molson's brewery". This conclusion is confirmed by the opponent's evidence relating to public recognition of the mark EXPORT.

Apart from the hexagonal-shaped border and the word EXPORT which is common to the applicant's trade-mark and the opponent's MOLSON EXPORT & Design and MOLSON'S EXPORT & Design trade-marks, there is little resemblance in the appearance of the trade-marks at issue when considered in their entirety as a matter of immediate impression and imperfect recollection. Further, the applicant's brewed alcoholic beverages would be identified orally either as PERONI NASTRO AZZURRO lager (beer) or as NASTRO AZZURRO lager (beer). As a result, and even if the average consumer were to refer to the opponent's brewed alcoholic beverages orally as EXPORT ale rather than MOLSON EXPORT ale, the trade-marks at issue still bear no similarity in sounding.

To the extent that the reading matter which forms part of the applicant's label design trade-mark would be considered as being in the Italian language, the trade-mark PERONI NASTRO AZZURRO & Design might suggest the idea that the applicant's brewed alcoholic beverages originate in Italy. Otherwise, the applicant's marks does not appear to suggest any particular idea. In view of the opponent's evidence that the public would identify EXPORT as a trade-mark of the opponent as opposed to identifying a brewed alcoholic beverage produced for export, the opponent's trade-marks would not appear to suggest any specific idea apart from being a brand of beer from Molson Breweries.

In view of the above, I have concluded that there would be no reasonable likelihood of confusion between the applicant's trade-mark and the opponent's MOLSON EXPORT & Design and MOLSON'S EXPORT & Design registered trade-marks.

The opponent also relied on the existence of its alleged family of trade-marks in respect of

its Section 12(1)(d) grounds of opposition. The concept of considering the issue of confusion other than by way of a mark by mark comparison as contemplated by the Trade-marks Act arose in McDonald's Corporation et al v. Yogi Yogurt Ltd. et al., 66 C.P.R. (2d) 101. In that case, Cattnach, J. stated that the presumption of the existence of a series of trade-marks arises when trade-marks which have common characteristics are registered in the name of one owner and are used by the one owner. In such a case, the learned trial judge noted that the "registration of such marks is tantamount to a single registration combined of those several marks". Further, Mr. Justice Cattnach goes on to state at pages 112-113:

"By that I mean that a mark which would be confusing with the registered marks is not confusing with those marks if the applicant therefor is the owner of all such trade marks. This well-known principle is recognized and perpetuated in s-s. 15(1) of the Act and which identifies such marks as "associated trade marks".

An application for a trade mark made by an applicant other than the registered owner of those trade marks which embodies the common characteristics thereof would be conflicting therewith and should be refused. That consideration does not apply when the applicant is the owner of the series and wishes to add to the series.

The fact of the registration of trade marks giving rise to the presumption of a series of marks existing is a most material consideration which the Registrar of Trade Marks must take into account upon an application for the registration of a mark embodying the common characteristics."

and at page 113:

"The reason for the presumption of there being a series of trade marks is clear.

When application for registration of a mark is made a search of the register is conducted. That search may disclose several marks having the same characteristic features in common with those in the mark applied for and which marks stand in the name of one owner or they may stand in the name of different proprietors.

As previously indicated if the former is the case the logical presumption is that the owner is using a series of marks. If the marks are registered it must also be presumed, in the absence of evidence to the contrary, that as at the date of the registration the owner was using those marks.

If the marks are owned by several different owners then the common characteristic is one well recognized in marks in use in the trade and is common thereto."

Also, at page 114, the learned trial judge notes:

"While the presumption of a series of trade marks can arise at the time of an application for the registration of a trade mark with the consequence indicated the same presumption does not arise in opposition proceedings. Before any similar inference as would arise from the presumption can arise in opposition proceedings based upon the use of the other marks any such use must be established by evidence.

The question therefore is whether the appellants have discharged the onus cast upon them of establishing the existence of a series of marks owned by the corporate appellant with which the application by the corporate respondent for the registration of the trade mark MCYOGURT may conflict. That is to be discharged by the establishment of the use of the trade marks sufficient to constitute a family."

The concept of a series of trade-marks being considered as a single registration when assessing confusion differs from the situation where an opponent, in alleging a likelihood of

confusion between one of its trade-marks and an applicant's mark, relies upon a group of its trade-marks each having an element common to the two trade-marks at issue. In such a case, the opponent could allege that its group of marks as registered and/or used constitutes a further surrounding circumstance under subsection 6(5) of the Act which supports its position in so far as there being a likelihood of confusion between its mark and the applicant's trade-mark. On the other hand, the applicant could rely upon the existence of third party registrations or use by third parties of trade-marks incorporating the common element in arguing that there would be little likelihood of confusion between the trade-marks at issue. It appears to me that it is the issue of confusion with its family of trade-marks as contemplated by Cattnach, J. which has been pleaded by the opponent as the last of its Section 12(1)(d) grounds of opposition.

The opponent has furnished evidence of the existence of a series or family of trade-marks as applied to brewed alcoholic beverages, each trade-mark including a hexagonally-shaped border element. As pointed out by Cattnach, J., there is an onus on a party seeking to rely upon the presumption of the existence of an alleged series or family of trade-marks to establish that it is the only person who has registered and used trade-marks which incorporate the common characteristic of the series. On the other hand, and as pointed out by the learned trial judge, the presumption of the existence of a series of marks is rebuttable if the applicant can establish the registration and use of other trade-marks standing in the name of other persons whose marks share the element or elements common to the trade-marks comprising the alleged series of marks relied upon by the opponent.

In the present case, the Lee affidavit evidences the existence of registrations for the trade-marks incorporating the hexagonal-shaped border element identified in the statement of opposition. Further, the photocopy of the Moran affidavit which is annexed as Exhibit X to Mr. Perkins affidavit, includes the following paragraphs which have been adopted by Mr. Perkins:

"21. The Brewing Group sells bottles and cans of beer in Canada which display the EXPORT, CANADIAN, GOLDEN, LITE or other Molson brand trade marks, as well as the "house mark" MOLSON within, or as an integral part of, a stylized hexagonal design. For example, the EXPORT brand label is hexagonally shaped and prominently displays the words MOLSON and EXPORT within a second stylized hexagon, which encloses yet a third stylized hexagon containing a ship in full sail. Similarly, the GOLDEN brand label is hexagonally shaped and prominently displays the words MOLSON and GOLDEN within a second stylized hexagon, which encloses a third hexagon containing a lion and crown design. The Brewing Group's major brand beer products are being sold in association with hexagonally shaped labels or in association with stylized hexagonal designs. Some of the family of hexagon and stylized hexagon design trade marks which are owned by The Molson Companies Limited are illustrated in the Affidavit of J. David Lee, which has been filed in this proceeding. These are a sample of the family of hexagonal design trade marks owned by The Molson Companies Limited. The following list represents the volume of such beer sold in Canada by the Brewing Group:

<u>Year</u>	<u>Volume in Gallons</u>
F1976	In excess of 79,000,000 (sic.)
F1977	In excess of 80,000,000
F1978	In excess of 83,000,000
F1979	In excess of 84,000,000
F1980	In excess of 90,000,000
F1981	In excess of 91,000,000
F1982	In excess of 97,000,000
F1983	In excess of 93,000,000
F1984	In excess of 85,000,000
F1985	In excess of 84,000,000
F1986	In excess of 83,000,000

21. (sic.) The hexagonal shape is distinctive of the Molson Companies Limited and the Brewing Group and is of such significance to the Molson corporate identity, that The Molson Companies Limited and the Brewing Group have adopted the stylized hexagonal design as a corporate trade mark. The trade mark which is shown in Exhibit S of the Affidavit of J. David Lee, appears on all corporate stationery, letterhead, envelopes, invoices, and corporate memorabilia. This corporate trade mark has been used by The Molson Companies Limited and the Brewing Group to identify the Corporation as a member of the Molson family, since at least as early as July 1984, when this current design replaced a similar, hexagonal design, which had been used for many years."

The opponent has not furnished a breakdown in sales of its brewed alcoholic beverages in association with each of the various trade-marks incorporating the hexagonal-shaped border design. Nevertheless, I am satisfied that the opponent has established by its evidence that there has been significant use of its marks incorporating a hexagonal-shaped design, thus confirming the existence of a series of trade-marks incorporating such a design as applied to brewed alcoholic beverages.

The applicant failed to file any admissible evidence relating to the existence of any registered trade-marks covering brewed alcoholic beverages incorporating a hexagonal-shaped border design similar to the hexagonally-shaped border elements in the trade-marks at issue. In particular, the design element of registration No. 312,027 and the design trade-mark covered by registration No. 140,068 bear little, if any, similarity to the hexagonal-shaped border elements of the trade-marks at issue. Further, registration No. 140,068 covers services of maintaining retail outlets for the sale of beer which differ from the wares of the parties.

Mr. Opolko has attached as Exhibit "E" (a representation of which appears below) to his affidavit what he has identified as being the "hexagonal label" from a bottle of COORS beer purchased by him. However, the shape of the border bears no similarity whatsoever to the hexagonally-shaped borders appearing in the trade-marks at issue. Certainly, if this is the best evidence which the applicant could locate to support its position that hexagonally-shaped border designs appear in labels of brewed alcoholic beverages in the marketplace, this evidence strongly supports the opponent's position that it, indeed, does have a family of design trade-marks incorporating hexagonally-shaped borders similar to that incorporated in the applicant's trade-mark.

Exhibit "H" to the Opolko affidavit is identified as a photograph of a selected group of cans and bottles of imported beer which the affiant located in a retail outlet of the Liquor Control Board of Ontario located in Toronto. According to Mr. Opolko, the photograph includes "the Hacker-Pschorr bottle because of its hexagonal label". However, the shape of the label on the bottle cannot be readily determined from the photograph and, having regard to what Mr. Opolko considers to be a hexagon as noted in his answers during his cross-examination (see answers to questions 40 to 43 and 72 to 102 of the transcript to the Opolko cross-examination), I am not prepared to accord any weight to this evidence.

The applicant submitted that its trade-mark includes an arcuate band including the word PERONI which interrupts the hexagonal border element of the mark. However, the hexagonally-shaped border still remains as a distinct, identifiable element of the applicant's trade-mark and has been described in the colour claim in the applicant's application as a "central hexagonal border". Further, two of the opponent's registered trade-marks identified in Exhibits 5 and 25 of the Lee affidavit, representations of which are set out below, cover design trade-marks in which the stylized hexagonally-shaped border is a dominant element of the trade-mark.

Registration No. 296,917 Registration No. 141,936

The trade-mark covered by registration No. 296,917 appears to be the corporate trade-mark which has been used by the opponent and the Brewing Group on all corporate stationery, letterhead, envelopes, invoices and memorabilia (see paragraph 21 of Exhibit X to the Perkins affidavit). In addition to services relating to the operation of a brewery, the registration covers brewed alcoholic beverages although I was unable to locate any specific evidence relating to use of the M & Design trade-mark on labels or packaging associated with brewed alcoholic beverages.

In view of the above, I have concluded that the applicant's evidence has failed to rebut the presumption of the existence of a series or family of trade-marks comprising hexagonal shaped border or label designs as applied to brewed alcoholic beverages standing in the name of the

opponent. Further, I have concluded that the applicant has failed to discharge the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark and the opponent's family or series of trade-marks including the hexagonal border design. In this regard, I am mindful of the fact that the applicant's trade-mark does include the element EXPORT which is common to the opponent's registered trade-marks noted above and in respect of which the opponent has adduced evidence of public recognition as being one of its trade-marks. Accordingly, the applicant's trade-mark PERONINASTRO AZZURRO & Design is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act. As a result, I have not considered the remaining grounds of opposition.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 27th DAY OF August, 1992.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.